

### **Remarks**

The present application is reviewed in light of the Office Action dated August 2, 2005. By the foregoing amendments, claims 1 and 5 are amended and claims 1, 4-5, and 8-10 are pending in this application. No new matter is introduced by the amendments.

With regard to the Examiner's requirement of a certified copy of the foreign application, Applicants respectfully submit that a certified copy of the foreign application was filed to the international authority during the PCT application stage and further note that the present application is a continuation of International Patent Application No. PCT/GB02/03811 filed August 19, 2002 as properly indicated in the Updated Filing Receipt of this application (a copy of which enclosed hereto). Accordingly, Applicants believe that refiling of such priority document to the U.S. Patent and Trademark Office is not required because the document or at least relevant information thereof can be obtained from the PCT authority.

The Examiner has rejected claims 1, 4-5 and 8 under 35 U.S.C. 102(b) as being anticipated by Dukor (US Patent No. 5,945,674). The Examiner has further rejected claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Dukor (US Patent No. 5,945,674) in view of Carter (US Patent No. 6,006,140).

Independent claims 1 and 5 have been amended by the foregoing amendments to more clearly highlight novel aspects of the present invention over the reference of record. Applicants respectfully submit that claims 1, 4-5, and 8-10 as amended are patentable over the references at least for the reasons discussed herein below.

As recited in the claims as amend, the present invention is directed to a method or system for operating an FT-IR microscope which is used in association with a

scanning spectrometer. The scanning spectrometer is operated in continuous scan mode and incremental movement of the moveable stage of the microscope is synchronized with the scans of the scanning spectrometer. One important characteristic feature of the invention is that movement of the microscope stage is initiated in response to a signal generated by the scanning spectrometer at the completion of the data collection step of a spectrometer scan. As such, the present invention allows movement of the microscope stage to be initiated immediately at the end of a scan and during a data transfer stage from the just completed scan, i.e., during the dead time between scans.

Contrary to the invention as claimed and as is specifically disclosed in the background section and the introductory part of the specification, for example in paragraphs [0003] to [0005], the conventional practice prior to the present invention was through a sequence of steps comprising stepping the motorized sample stage to the next sample location, beginning a spectrometer scan, waiting for the spectrometer scan to complete and stopping the scan, transferring the data and then stepping the sample stage to the next sample location. This conventional procedure involves substantial delays as each operation waits for the previous one to complete and scan result in relatively long periods of time being involved in collecting a reasonably sized image.

In rejecting claims 1, 4-5 and 8 under the anticipation ground by Dukor (US Patent No. 5,945,674), the Examiner has noted that Dukor discloses a system and method for operating an FT-IR microscope 20 with a scanning spectrometer 25 in continuous scan mode, and that Dukor further discloses that "after the ATR infrared measurement is performed on one detection site in the sample, the object stage 22 is moved under the control of the scan controller so that the next detection site is positioned for ATR infrared measurement".

Applicants respectfully submit that Dukor fails to disclose or teach the invention as recited in claims 1, 4-5, and 8-10 as amended because there is nothing in Dukor to suggest that movement of the microscope stage is initiated immediately at the end of the data collection step of a scan and before the completion of a data transfer stage. There is nothing in Dukor to suggest that the system operates other than in the conventional way discussed above and described in the introductory part of the present application. Dukor is totally silent as to when initiation of movement of a microscope stage is carried out in relation to a scan. In fact, it is difficult for one skilled in the art to see how this stage movement can be synchronized in any way with the scan since Dukor apparently discloses only link between the scan controller 23 which controls movement of the microscope stage 22 and the spectrometer 25. Thus there is nothing in this document to suggest that the movement of the microscope stage is initiated in response to a signal generated by the scanning spectrometer at the completion of a data collection step of a spectrometer scan as required by the claims of the present invention.

Accordingly, in view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1, 4-5, and 8-10 as amended are patentably distinct over Dukor.

Similar to the Dukor disclosure discussed above, Carter (US Patent No. 6,006,140) fails to disclose or suggest that incremental movement of the moveable stage of the microscope is synchronized with the scans of the scanning spectrometer in which the movement of the microscope stage is initiated in response to a signal generated by the scanning spectrometer at the completion of a data collection step of a spectrometer scan as required by the claims of the present invention.

Applicant further respectfully submits that it would not have been obvious to modify the cited references, either alone or when combined, to arrive at the present

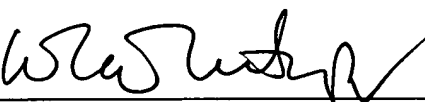
invention as claimed. It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the modification or combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In the present case, Applicant respectfully submits that there is absolutely no motivation provided in either of the references to make the modifications necessary to arrive at the claimed invention.

Accordingly, Applicants respectfully submit that claims 1, 4-5, and 8-10 as amended are patentably distinct over the prior art references of record.

For the foregoing reasons, Applicants submit that all of the claims currently pending (i.e., claims 1, 4-5, and 8-10) in the application are now in condition for allowance. Favorable reconsideration and early notice to that effect is respectfully requested.

Respectfully submitted,

December 1, 2005

  
Wesley W. Whitmyer, Jr. Registration No. 33,558  
Hyun Jong Park, Limited Recognition No. L0076  
Attorneys for Applicants  
ST.ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619  
203 324-6155